REMARKS

Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,649,174, allegedly since, although the conflicting claims are not identical, they are not patentably distinct from each other because the instant independent claims encompass the patent claim regarding the film forming agent and ratio. To obviate this rejection, the Applicants are directed to submit a terminal disclaimer in compliance with 37 CFR 1.321(c), as the conflicting patent is commonly owned with the present application. Nevertheless, the Applicants request that the submission of a terminal disclaimer be postponed until such time as the scope of the claims has been finally determined, if still appropriate.

Claims 1, 2, 4-8, and 11-19 are rejected under 35 U.S.C. 103(a) allegedly as being unpatentable over Touzan et al. (hereinafter "the '496 reference") in view of Shah et al. (hereinafter "the '155 reference"). The Examiner states:

> "Touzan et al teach a two phase composition for cleansing containing a demixing agent (title, abstract). An aqueous and separate oily phase in a ratio of 30:70-60:40 is disclosed (abstract). Isohexadecane, liquid paraffins, and silicone oils including cyclopentadimethylsiloxane are disclosed (column 4 lines 1-20). Colorants are specified (column 4 line 25).
> Shah et al teach a polyvinylpyrrolidone/vinyl acetate copolymer at 1-5% to maintain pigments in suspension (column 4 lines 37-57).
> It would have been obvious to one of ordinary skill to add a polyvinylpyrrolidone/vinyl acetate copolymer to the composition of Touzan et al for the beneficial effect of maintaining colorants in suspension in view of Shah et al."

This rejection is respectfully traversed. The present invention is a dual phase liquid cosmetic composition comprising an aqueous phase and an oil phase in the ranges set out in the claims. The phases are separate from one another before and after being mixed at the time of use. The composition contains as a demixing agent, a film forming agent. In a preferred embodiment of the present invention, the film forming agent is non-cationic. The '496 reference also teaches a dual phase emulsion composition having an aqueous phase and an oily phase. However, the aqueous phase contains a particular demixing agent, alkyldimethylbenzylammonium ("benzalkonium") chloride, which is not a film forming agent. The '155 reference teaches a dual phase composition; however, unlike the composition of the '496 reference, the two phases of

the '155 reference are both aqueous and therefore miscible. One aqueous phase of the '155 reference is a gel phase, while the other phase is a color phase. As disclosed at column 8, lines 2-14 of the '155 reference, the color phase is manipulated and disposed in the container against a background of the gel phase such that the color phase appears completely engulfed in the gel. For use, the two phases are mixed to form a homogenous composition. Thus, the two phases are kept separated before use. As further taught in the '155 reference, each phase can contain PVP. The gel phase, as taught a t column 5, lines 55-65, includes a water soluble resin as a thickener, preferably of the crosslinked acrylic acid polymer family, and can be PVP. The color phase contains a protective colloid to maintain the pigment in suspension. PVP and PVP/VA copolymer may be used for this purpose.

It is the Examiner's assertion that it would have been obvious to one of ordinary skill in the art to incorporate PVP in the compositions of the '496 reference to maintain colorants in suspension in view of the '155 reference, and thus arrive at the present invention. The Applicants cannot agree with the Examiner's reasoning. The colorant, as taught in the '155 reference, is added to the color phase in the amount of 1-60 weight percent. However, in each of the 19 examples described in columns 8-15 of the '155 reference, the colorant is present in the color phase in an amount in the range of about 30-40%. PVP is the protective colloid present in each example. It is the presence of the PVP which maintains the pigments in suspension in the color phase and prevents the bleeding of the colorant into the gel phase. As discussed at column 7, lines 66-68, the two phases are disposed in discrete side by side phases in the container. Unlike the compositions in the '155 reference, the use of pigment in the emulsion compositions of the '496 reference is disclosed in only one example, Example 4. The amount of the colorant used is a mere 0.05 weight percent. The '496 reference is otherwise silent on the amount of pigment which may be used. Therefore, since in the entire reference, there is only the teaching to use 0.05 weight percent of colorant, the amount of colorant which is taught or suggested as useful and/or desirable in the '496 reference compositions must be limited to the example. This amount is 20 times less than the minimum 1% colorant disclosed in the '155 reference, and it is 600 less than the amounts employed in the examples in the '155 reference. Clearly, an emulsion formulator of ordinary skill in the art, would not have appreciated any need for, nor any benefit to, introducing the PVP disclosed in the '155 reference, where it is used for suspending a large amount of pigment in one aqueous phase of a composition and

preventing it from bleeding into another aqueous phase of the composition, into the emulsion compositions of the '496 reference which optionally contain a mere 0.05 weight percent colorant.

For the above reason alone, the combination of the '496 and the '155 references suggested by the Examiner cannot be viewed as a sound one, and the rejection of the claims in view of this combination references should not be maintained. However, there is a further reason that one skilled in the art would not have combined the references as the Examiner has done. PVP is known for use as a film former and suspension stabilizer. This, and the fact that the '155 reference employs PVP to suspend pigments teaches away from the achievement of the present invention wherein PVP performs a demixing function. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the claimed invention. *In re Gurley,* 31 USPQ2d 1130, 1131 (CAFC 1994).

A further reason that one skilled in the art would not have combined the '496 and the '155 references in an attempt to arrive at the present invention is that the compositions taught in the '496 reference are emulsion compositions containing an aqueous phase and an oily phase, and a demixing agent which facilitates the rapid separation of the phases after mixing. On the other hand, the compositions of the '155 reference contain two miscible aqueous phases which are kept separate until they are mixed at the time of use into a homogeneous composition which is not subsequently demixed. Those of ordinary skill in the art would appreciate that formulating a stable emulsion is a formidable task and that one does not easily introduce a further ingredient into such stable emulsion without some prediction as to the behavior of that ingredient in the stable emulsion composition; that is, some indication that the further ingredient will not upset the delicate balance achieved in the stable emulsion. In view of the fact that PVP is a known suspension stabilizer, one skilled in the art would predict that PVP would interfere with the demixing function of the dual phases of the compositions of the '496 reference. The use of the PVP for suspending is divergent and contrary to demixing.

Furthermore, there is no teaching or suggestion in either of the '496 or the '155 references to incorporate PVP into the oil phase of a composition, as recited in claims 21 and 22 of the present application. The '155 reference teaches two aqueous phases, and

therefore cannot teach or suggest using PVP in an oily phase. As noted in the '155 reference, at column 1, line 66, colorants easily migrate. The '155 reference also teaches against and discourages the use of an oil phase. At column 1, lines 29-35 of the '155 reference, it is taught that it is undesirable to use an oil phase because of the difficulty in removing the non-water soluble phase. In the compositions of the '496 reference, it is also the aqueous phase which contains the demixing agent. Moreover, in view of the difficulty taught in the '155 reference of using an oil phase, one skilled in the art would not have a reasonable expectation of success when adding the PVP to the aqueous phase of the '496 emulsion compositions containing an oily phase.

Additionally, as the '496 reference and the '155 reference compositions clearly possess entirely different properties, the former being an emulsion including aqueous and oily phases which are mixed temporarily and rapidly demixed, and the latter being a dispersion of two aqueous phases which are mixed to homogeneity, one skilled in the art would not have had a reasonable expectation of success in combining the teachings in these references. For all of the above reasons, it is considered that the Examiner has not established a *prima facie* case of obviousness, and that the rejection of the claims under 103(a) must be withdrawn.

Claims 1, 2, 4-8 and 10-22 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy et al (hereinafter "the '758 reference") in view of Grollier et al (hereinafter "the '095 reference"). The Examiner states:

> "Nagy et al teach a makeup removing composition comprising two phases and a demixing agent (abstract). A 30:70-70:30 ratio of oil to aqueous phase is disclosed (column 3, lines 12-14). Mixtures of cyclic silicones, dimethicone and a volatile C16 paraffin are specified (column 4, lines 33-53).
> Grollier et al teach two phase compositions comprising a cationic polymer for skin conditioning (abstract). Vinyl pyrrolidone-acrylamide copolymers are specified at 0.2-50% (column 8, lines 1-26, column 9, lines -24).
> It would have been obvious to one of ordinary skill to add a vinylpyrrolidone-acrylamide copolymer to the composition of Nagy et al to achieve the beneficial effect of a skin conditioner in view of Grollier et al."

This rejection also is respectfully traversed. The '758 reference teaches a liquid dual phase emulsion composition comprising an oil phase and an aqueous phase and a specific class of cationic demixing agent, a quaternary nitrogen-containing ether

substituted alkoxylated alkyl glucoside. The demixing agent, being water-soluble is preferably added in the aqueous phase of the composition (column, 3, lines 4, 5 of the reference). The '095 reference teaches a non-detergent composition having two separately packaged compositions that are only mixed at the time of application; the composition being shaken to disperse the aqueous phase in the oily phase. One of the liquid phases is an aqueous phase in which a cationic polymer is dissolved. The cationic polymer, as described at column 2, line 64 – column 9, line 14, includes vinylpyrrolidone acrylate or methacrylate copolymers of aminoalcohol. The suspension of cationic polymer in alcohol is known to be irritating to the eyes; in fact the compositions of the '095 reference are intended for use on the hair or skin. The other phase is an oily phase as disclosed at column 2, lines 16-23, which includes non-volatile oils. The '095 reference teaches against incorporating the cationic polymer into an oily phase. As taught and/or suggested in the reference, the desirable properties of the cationic polymer will be compromised if it is incorporated in an oily phase. Specifically, at column 1, lines 53-57, it is taught that, although it is possible to incorporate the cationic polymer in the oil phase, its effectiveness is very slight.

Although the Examiner alleges that it would have been obvious to combine the teachings of the '758 and the '095 references to achieve the present invention, the Applicants cannot agree with this reasoning. The compositions of the '758 reference and the '095 reference clearly possess entirely different properties, the former compositions being emulsions including aqueous and oily phases which are mixed temporarily and rapidly demixed, and the latter compositions which, when mixed, form dispersions of an aqueous phase in an oily phase and which do not demix. As discussed above, with regard to the '496 and the '155 references, those of ordinary skill in the art would appreciate that formulating a stable emulsion is a formidable task and that one does not easily introduce a further ingredient into such stable emulsion without some prediction as to the behavior of that ingredient in the stable emulsion composition; that is, some indication that the further ingredient will not upset the delicate balance achieved in the stable emulsion. In view of the fact that the cationic polymers are known surfactants which lower the surface tension of water and help to stabilize emulsions, one skilled in the art would predict that the addition of the cationic polymers of the '095 reference to the stable emulsion of the '758 reference would interfere with the demixing function of the dual phases of the compositions of the '758 reference. The use of the cationic polymers for stabilizing emulsions is divergent and contrary to demixing. One skilled in

the art would not have had a reasonable expectation of success in combining the teachings in these references.

Additionally, there is no teaching or suggestion in either reference to incorporate the cationic polymer into the oil phase of a composition, as recited in claims 21 and 22 of the present application. Furthermore, present claim 8 requires the demixing agent to be a non-cationic film forming agent. Claim 9 further specifies these non-cationic film forming agents. The '758 and the '095 references teach only cationic polymers as a demixing agent (the '758 reference) or as a conditioning agent (the '095 reference). Neither reference therefore can teach or suggest the present invention as claimed in claim 8 and its dependent claims which require a non-cationic film forming agent. For these additional reasons, it is considered that the Examiner has not established a *prima facie* case of obviousness, and that the rejection of the claims under 103(a) should be withdrawn.

CONCLUSION

In view of the arguments presented above, in the present submission, the claims are believed to be in condition for allowance, and the issuance of a Notice of Allowance is respectfully requested. A petition and fee for extension of time for three months is being submitted together with this response.

Respectfully submitted,

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